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UNITED STATES DEPARTMENT OF COMMERCE  
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SCHENKMAN ATTORNEY DOCKET NO.

SERIAL NUMBER  
PATRICIA GRANAHAN  
HAMILTON, BROOK, SMITH & REYNOLDS  
TWO MILITIA DRIVE  
LEXINGTON, MA 02173FILING DATE  
12M2/0607

EXAMINER

1205

ART UNIT  
04/07/93

26

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

 This application has been examined Responsive to communication filed on 2/16/93. This action is made final.

A shortened statutory period for response to this action is set to expire 5 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

## Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.	2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.
3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.	4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152.
5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.	6. <input type="checkbox"/>

## Part II SUMMARY OF ACTION

1.  Claims 1 - 6, 8 + 15 - 18 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 1 - 6, 8 + 15 - 18 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable.  not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been  approved by the examiner.  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed on \_\_\_\_\_, has been  approved.  disapproved (see explanation).

12.  Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

## EXAMINER'S ACTION

Art Unit 1205

1. The application has been reviewed and, in response to the Status Inquiry, an action on the merits follows:

2. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

3. Claims 1-6 and 15-18 are rejected under 35 U.S.C. § 103 as being unpatentable over Chemical Abstracts for reasons of record.

4. Claims 1-5 are rejected under 35 U.S.C. § 103 as being unpatentable over Brittain et al, Hartley et al and Buckner et al for reasons of record.

5. Claims 6, 8 and 15-18 are rejected under 35 U.S.C. § 103 as being unpatentable over Brittain et al, Hartley et al and Buckner et al as applied to claims 1-5 are above, and further in view of Chemical Abstracts for reasons of record.

Art Unit 1205

6. Neither applicants' arguments or the Alberg declaration obviate the propriety of the rejections. Comments regarding the unobviousness of using the R(-) isomer is not persuasive. Note, for example the summary of the Brittain et al Article regarding the desirability of using the R(-) isomer and its effects on  $\beta$ -adrenoreceptors. Applicants has failed to show unexpected activity or less undesirable side effects (e.g. comparative therapeutic indices). Again, applicants are reminded that such a showing ,if made, may not be persuasive in view of the In re Adamson decision.

The term R-(claim 18) should be R(-).

SCHENKMAN:jd  
May 24, 1993

*Le昂ard Schenkman*  
LEONARD SCHENKMAN  
EXAMINER  
ART UNIT 125